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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/499,693 02/08/00 LEE

I 00120/P-4858

EXAMINER

HM22/0828

WENDEROTH, LIND & PONACK, L.L.P.
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WELLS, J

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/499,693

Applicant(s)

LEE ET AL.

Examiner

Lauren Q Wells

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-2 and 5-22 are pending in the application. Claims 3-4 were cancelled and claims 5-22 were added per the Amendment dated July 30, 2001. Claims 9-17 are withdrawn from consideration as being drawn to a nonelected invention.

Newly submitted claims 9-17 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the method of maximizing the synthesis of an acid in vivo is not related to a composition comprising unsaturated fatty acids.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed July 30, 2001 (Paper No. 5) to the rejection of claims 1-4 made by the Examiner under 35 USC 102 (b) and (e) have been fully considered and deemed not persuasive. The rejection of claims 1-4 made by the Examiner under 35 USC 112 have been withdrawn per Applicant's amendment.

102 Rejection Maintained

The rejection of newly added claims 18-22 (which corresponded to original claim limitations 1-4) under 35 U.S.C. 102(b) as being unpatentable over Schmidl et al. is MAINTAINED for the reasons set forth in the Office Action mailed March 29, 2001, Paper No. 3, and those found below.

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Applicant argues that "Schmidl et al. is not directed to a composition comprising substantially all fatty acids as required by the amended claims". This argument is not persuasive in regards to claims 18-22, as Schmidl et al. teach nutritional compositions comprising 4-30% lipid component, 65-80% carbohydrate components, and 16-25% protein content, wherein the lipid component preferably comprises omega-6-polyunsaturated fatty acids (linoleic acid) and omega-3 polyunsaturated fatty acids (linolenic acid). The Examiner respectfully reminds the Applicant that the transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 11261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 705, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948)("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). See MPEP 2111.03.

In response to applicant's argument that "the claimed ratios have a superior and unexpected property as compared to that disclosed in Schmidl", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The rejection of claims 1-2 and newly added claims 5-8 and 18-22 under 35 U.S.C. 102(e) as being unpatentable over Igarashi is MAINTAINED for the reasons set forth in the Office Action mailed March 29, 2001, Paper No. 3, and those found below.

Applicant argues "with regard to the rejection. . . as being anticipated by Igarashi (6,159,507), this rejection is overcome by the filing of the verified translations of the certified priority documents". This argument is not persuasive. The Igarashi patent (6,159,507) is a continuation of Application No. 08/793,316, filed as application No. PCT/JP96/01858, Jul. 4, 1996, and further claims foreign priority to a Japanese application filed Jul. 4, 1995. Thus, according to USC 102(e), Igarashi has a priority date of July 4, 1996 which is prior to the filing date of the instant application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
August 10, 2001


DAMERON L. JONES
PRIMARY EXAMINER